

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: CHRISTOPHER E. MITCHELL
and WEI-QUIANG MICHAEL GUO

MAILED

MAY 25 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/836,584

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on May 18, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

A review of the file indicates that on October 28, 2005, appellants filed an Appeal Brief that is not in compliance with the new rules established on September 13, 2004, under 37 CFR § 41.37(c).

Accordingly, 37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) ***Related proceedings appendix.*** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

A review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed October 28, 2005:

- 1) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that a substitute Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

EXAMINER'S ANSWER

On January 12, 2006, an Examiner's Answer was mailed, responding to the original Appeal Brief filed October 28, 2004. A review of the Examiner's Answer reveals it is not in compliance with the Manual of Patent Examining Procedure.

See MPEP §1207.02 which states:

(8) Evidence Relied Upon

A listing of evidence relied on (e.g., patents, publications, admitted prior art), and in the case of non-patent references, the relevant page or pages.

Correction of the record is required.

REPLY BRIEF

A Reply Brief in response to the Examiner's Answer dated January 12, 2006, was filed on May 12, 2006. However, a review the Image File Wrapper (IFW) reveals that the Reply Brief has not been considered or acknowledged by the examiner. A written communication notifying appellant of the Examiner's receipt and consideration of the Reply Brief is required. Further, a two month extension of time fee was required and authorized to be paid by the appellant at the time of filing of the Reply Brief.

Acknowledgment of the Reply Brief is required and the appropriate two month extension of time fee needs to be charged to the deposit account as authorized by the appellant.

Lastly, the PALM system has not been updated to reflect receipt of the Reply Brief. PALM needs to be updated.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the examiner to:

(1) hold the Appeal Brief filed on October 28, 2005, defective;

(2) to notify appellants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;

(3) to vacate the Examiner's Answer mailed January 12, 2006, to consider the substitute Appeal Brief and submit a revised Examiner's Answer setting forth all the required sections in accordance with the new rules effective September 13, 2004;

(4) Acknowledge the Reply Brief that may be filed in response to the Examiner's Answer; and

(5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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